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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/018,073

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Jean L Lalanne

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12/22/2004

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EXAMINER

KAM, CHIH MIN

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,073

Applicant(s)

FAUVEAU ETAL

Examiner

Chih-Min Kam

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-15, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 15, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION.

1. The finality of previous Office Action dated October 13, 2004 is withdrawn due to a new ground rejection.

Status of the Claims

2. Claims 1-11, 13-15, 19 and 20 are pending.

Applicants' amendment filed November 19, 2004 is acknowledged. Applicant's response has been fully considered. Claim 1 has been amended. Therefore, claims 1-11, 13-15, 19 and 20 are examined.

Rejection Withdrawn

Claim Rejections-Obviousness Type Double Patenting

3. The previous rejection of claims 1-11 and 13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 8-11, 14 and 17-20 of U. S. Patent 6,677,429 is withdrawn in view of a terminal disclaimer filed November 19, 2004, and applicant's response at page 9 in the amendment filed November 19, 2004.

Claim Rejections - 35 USC § 112

4. The previous rejection of claims 1-11, 13-15, 19 and 20 under 35 U.S.C.112, second paragraph, regarding the term "all possible isomeric forms and their mixtures" and lacking essential steps in the method of treating fungal infection, is withdrawn in view of applicant's amendment to the claim, and applicant's response at pages 9-10 in the amendment filed November 19, 2004.

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Claim Rejections - 35 USC § 102

5. The previous rejection of claims 1-11 and 13 under 35 U.S.C. 102(e) as being anticipated by Courtin *et al.* (U. S. Patent 6,677,429) is withdrawn in view of that the 102(e) date (July 24, 2000) of the patent is after the effective filing date (June 8, 2000) of the instant application.

Although applicant has responded to the rejection under obviousness-type double patenting by filing a terminal disclaimer, applicant has not responded to the rejection under 35 U.S.C. 102(e).

Informalities

The disclosure is objected to because of the following informalities:

6. The specification recites the misspelled word “echinocandine” (e.g., at page 11, line 8), and isomer B does not have the same numbers of left bracket ([) and right bracket (]) in the nomenclature. Appropriate correction is required.

Claim Objection

7. Claims 15, 19 and 20 are objected to because claim 15 recites the misspelled word “echinocandine”, and isomer B does not have the same numbers of left bracket ([) and right bracket (]) in the nomenclature.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-7, 11 and 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. Claims 1-7, 11 and 13-14 are indefinite because of the use of the term "R is selected from the group consisting of alkyl and cycloalkyl of up to 30 carbon atoms, optionally containing at least one heteroatom, at least one heterocycle and alkyl or cyclic acyl of up to 30 carbon atoms optionally containing at least one heteroatom, and at least one heterocycle". The term cited renders the claim indefinite, it is unclear whether alkyl and cycloalkyl contain heterocycle, and whether alkyl or cyclic acyl contains heterocycle. Claims 2-7, 11 and 13-14 are included in the rejection because they are dependent on rejected claims and do not correct the deficiency of the claim from which they depend.
10. Claim 13 recites the limitation " $-\text{CH}_2-\text{C}(\text{CH}_2)_2-\text{NH}_2$ " in line 2. There is insufficient antecedent basis for this limitation in claim 1. Claim 13 is also indefinite because there is no period "." at the end of the sentence.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 1-11 and 13 are rejected under 35 U.S.C. 102(a) as anticipated by Courtin *et al.* (WO 99/29716, published date June 17, 1999; English Equivalent: U. S. Patent 6,677,429). The instant application claims foreign priority of France 99/07251, filed June 9, 1999, however, the English translation of the foreign priority document is not provided, thus the priority date is not perfected.

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Courtin *et al.* teach a compound of formula I consisting of all possible isomeric forms, where R_1 and R_2 are individually selected from the group consisting of hydrogen, OH, alkyl of up to 8 carbon atoms optionally interrupted with oxygen and optionally substituted with halogen, OH and N(-a) (-b), where a and b are individually hydrogen or alkyl of up to 8 carbon atoms (column 1, lines 10-54; columns 3 and 4; claims 1, 2, 4, 5, 8-11, 14 and 17 of the patent), which meet the criteria of claims 1-11 and 13, when R_2 is a specific amine- or hydroxy-containing alkyl group (e.g., $-\text{CHCH}_3\text{CH}_2\text{NH}_2$ or $-(\text{CH}_2)_a\text{OH}$, where a is an integer of 1 to 8).

Conclusions

12. Claims 1-11, 13 and 14 are rejected, and claims 15, 19 and 20 are objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Patent Examiner

CMK

CMK
December 15, 2004


JON WEBER
SUPERVISORY PATENT EXAMINER